

REMARKS

Favorable reconsideration and allowance of the claims of the present application, as amended herein, are respectfully requested.

Applicants have amended Claims 1 and 4 in a manner as shown above. Support for the amendment to Claim 1 is found at paragraph [0001] of page 1. The amendment to Claim 4 corrects a grammatical error in the previous version of the claim. Since the amendments to the claims do not introduce new matter into the present application, entry thereof is respectfully requested.

In the Official Action, Claims 1-10 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Official Action contends that the limitation “free of...carrier materials” recited in Claim 1 is not supported by the originally filed specification, nor the originally filed claims.

In response, Applicants respectfully submit that, first, the limitation is “free from...carrier materials”, rather than “free of...carrier materials” as alleged by the Official Action. Second, the limitation of “free from...carrier materials” is fully supported by the originally filed specification. See paragraph [0042] at page 8.

In view of the above remarks, Applicants respectfully submit that the instant indefiniteness rejection has been obviated. Reconsideration and withdrawal of the same is respectfully requested.

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,458,387 to Scott et al. (“the ‘387 patent”) in view of Japanese Patent Application JP 07096166 A (“the ‘166 patent application”).

In the response submitted on June 10, 208, Applicants have argued that the '387 patent teaches away from the present invention since it requires the presence of a carrier material in the formation of the microspheres, which is contrary to what is claimed in the present invention. Specifically, the microspheres recited in the '387 patent require the presence of a carrier material, such as, for example, a carrier protein. See column 3, lines 27–30 and 51-55, and column 42, line 48. In contrast, the microcapsules claimed in the present application are free from carrier materials.

In response to the above remarks, the Official Action, referring to column 3, lines 51-52 of the '387 patent, contends that the '387 patent teaches that not only a carrier protein can be incorporated into the microspheres, but also a therapeutic protein. The Official Action, therefore, appears to assert that the microspheres recited in the '387 patent does not require the presence of a carrier material because a therapeutic protein can be incorporated into the microspheres.

In response, Applicants respectfully disagree with the above interpretation of the '387 patent because it appears that the Official Action merely picks the first sentence without taking into account the rest of sentences in the same paragraph. Specifically, although the first sentence of the last paragraph on column 3 reads as “[t]he protein component of the microsphere may be a carrier protein or a therapeutic protein”, after carefully reading the subsequent sentences in the same paragraph, for example, “[t]he carrier protein can also be a therapeutic protein, i.e., a protein which has a therapeutic activity; however, in general, the phrase ‘carrier protein’ will be used in this application to refer to a protein which has a primary function to provide a three dimensional structure for the purpose of microsphere formation, even if the carrier protein also may have a secondary function as a therapeutic agent,” a person

skilled in the art would understand that the '387 patent teaches that a carrier protein is an indispensable component of the microspheres because its role is to provide a three dimensional structure for the purpose of microsphere formation. Sometimes, the microspheres may comprise a carrier protein and a therapeutic protein, or only a carrier protein which by itself is also a therapeutic protein. However, when there is no carrier protein in the microspheres, such microspheres would not be formed because it is the carrier protein, rather than the therapeutic protein that plays the role of providing a three dimensional structure for the purpose of microsphere formation.

In view of the above remarks, Applicants submit that the microspheres recited in the '387 patent require the presence of a carrier material, for example, a carrier protein. As such, the '387 patent teaches away from the present invention because the microcapsules claimed in the present application are free from carrier materials.

With respect to the secondary reference, e.g., the '166 patent application, and in the response submitted on June 10, 2008, Applicants have argued that the '166 patent application discloses a cosmetic preparation wherein porous fine particles, other than copolymers, are required in the preparation of the microcapsules. See page 2, paragraphs [0009] and [0012]; and page 3, paragraph [0023]. Therefore, the applied secondary reference also teaches away from the present invention because the microcapsules recited in the present invention are free from porous materials. See page 1, paragraph [0001].

In response to the above remarks, the Official Action contends that the purpose of citing the '166 patent application is mainly to point out that the claimed copolymer, which is also used in the '387 patent, can be dissolved in pH 4.5-6.5.

In response, Applicants submit that no matter what is the purpose of citing a prior art reference, “the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference.” See MPEP 2143.01 V and VI. Applying this principle to the present case, and in order to arrive at the present invention which is free from porous materials, a person skilled in the art would have to discard the porous fine particles which is a required component of the microcapsules disclosed in the ‘166 patent application. Therefore, such a modification clearly would violate the above-described principle because by eliminating an indispensable component, it certainly would render the ‘166 patent application unsatisfactory for its intended purpose or change its principle of operation.

In summary, Applicants submit that a person skilled in the art would not combine the cited references in the first place because they teach away from the present invention. Moreover, even assuming *pro argundo* that a person skilled in the art would combine the cited references, which is clearly not the case as discussed above, such a combination would not arrive at the present invention, because the combination of the cited references at most teaches a microcapsules wherein porous materials and/or carrier materials are present, which is completely opposite to the present invention wherein the microcapsules are free from porous materials and carrier materials.

Furthermore, even assuming the cited references present a prima facie case of obviousness, which is simply not true, that case can be rebutted by a showing of unexpected results. To that end, Applicants observe that they have made several surprising finds for the present claimed cosmetic preparation. Specifically, the microcapsules, which are free from porous materials and carrier materials, eliminate the remaining residues of hard core materials

on the skin which can impair the physiological compatibility or bring about cosmetically undesired effects, and thus provide more pleasant feel on the skin. Moreover, without using the porous and carrier materials, such microcapsules can have a reduced size and can carry more active ingredients, and thus provide an easier and pleasant cosmetic application on the skin. See page 8, paragraph [0040] to [0042]. As such, this showing of unexpected results rebuts any presumption of obviousness created by the cited references.

In view of the above remarks, the conclusion is compelling that the present invention is not obvious over the applied references.

The rejection under 35 U.S.C. § 103 has been obviated; therefore reconsideration and withdrawal thereof are respectfully requested.

Thus, in view of the foregoing amendments and remarks, it is firmly believed that the present case is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'LSZ', with a long horizontal flourish extending to the right.

Leslie S. Szivos, Ph.D.
Registration No. 39,394

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
LSS/AZ:dk